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TRANSMITTA	Docket No. SHO-0034			
In re Application of: Kazul	ki EMORI	,		
Application No. 10/697,157-Conf. #9101	Filing Date October 31, 2003		aminer H. Lim	Group Art Unit
Invention: GAMING MAC	HINE			
	TO THE COMMISSIONER	OF PATEN	TS:	- <u> </u>
Transmitted herewith is the filed: May 20, 2008	Appeal Brief in this applicatio	n, with respe	ect to the Notice	e of Appeal
The fee for filing this Appeal X Large Entity	Brief is 0.00 Small Entity			
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Carl Schadkowitch			Dated: A	august 25, 2008
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N THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Attorney Docket No.: SHO-0034

Kazuki EMORI

Examiner: S. H. Lim

Application No.: 10/697,157

Art Unit: 3714

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597,157 | Art Unit: 371

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Filed: October 31, 2003

Confirmation No.: 9101

For:

GAMING MACHINE

APPEAL BRIEF

MS APPEAL BRIEF - PATENTS

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir:

Under 37 C.F.R. §41.37, this Appeal Brief is in furtherance of the Notice of Appeal, filed in the above-identified application on May 20, 2008, and appeals the final decision of the Examiner in the final Office Action dated January 25, 2008.

The fees required under § 41.20 and any required petition for extension of time for filing this brief and fees therefor, are provided in the accompanying Transmittal of Appeal Brief. Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

In compliance with 37 C.F.R. §41.37(a)(1), one (1) copy of this Appeal Brief is hereby filed.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37:

I. Real Party In Interest

II Related Appeals and Interferences

III. Status of Claims

IV. Status of Amendments

V. Summary of Claimed Subject Matter

VI. Grounds of Rejection to be Reviewed on Appeal

VII. Arguments

VIII. Claims

IX. Evidence

X. Related Proceedings

XI. Conclusion

Claims Appendix

Drawing Figures Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Aruze Corp. of Tokyo, Japan ("Aruze") is the real party in interest of the present application. An assignment of all rights in the present invention to Aruze was executed by the inventors and recorded by the United States Patent and Trademark Office on reel 015297, frame 0708.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

now being appealed	(rejected)	Claim 1
now being appealed	(rejected)	Claim 2
now being appealed	(rejected)	Claim 3
now being appealed	(rejected)	Claim 4
now being appealed	(rejected)	Claim 5
now being appealed	(rejected)	Claim 6

IV. STATUS OF AMENDMENTS

The Examiner issued an Advisory Action dated May 15, 2008, in response to Applicant's Response after Final Rejection under 37 CFR 1.116 filed on April 28, 2008. Applicants' Response after Final Rejection was filed in response to the final Office Action dated January 25, 2008. No amendments were made to the claims in Applicants' Response after Final Rejection.

Accordingly, claims 1-6 enclosed herein and recited in Appendix A are the pending claims of the application subject to this appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A gaming machine 1 (page 8, line 21, et. seq.; Figures 1 and 2) includes a cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2), a belly panel 100 (frame member 110 and semi-transparent member 120; page 34, lines 19-24 et. seq.; Figure 16), a symbol row display device 3L, 3C, 3R (page 16, lines 5-6; Figure 2), an operation input device 6 (page 14, lines 1-2; Figures 1 and 2), an internal lottery device 71 (page 21, lines 2-3; Figure 6), an illumination device 104 (page 36, line 25, et. seq.; Figures 16), a transparent member placement part 103 (page 37, line 4, et. seq.; Figures 14-16) and a transparent member 105 (page 37, lines 10-16, et. seq.; Figures 13A-16). The cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2) has a front side (Figures 15-16)

and the belly panel 100 (frame member 110 and semi-transparent member 120; page 34, lines 19-24, et. seq.; Figures 1 and 2) is releasably connected to the cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2) and is operable to move to a cover state (Figure 16) where a portion of the front side (Figures 15-16) of the cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2) is covered by the belly panel 100 (frame member 110 and semi-transparent member 120; page 34, line 5, et. seq.; Figures 1 and 2) and an exposed state (Figures 14-15) where the portion of the front side (Figures 15-16) of the cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2) is uncovered when the belly panel 100 (frame member 110 and semi-transparent member 120; page 34, line 5, et. seq.; Figures 1 and 2) is positioned away from the cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2). The symbol row display device 3L, 3C, 3R (page 16, lines 5-6, et. seq.; Figure 2) is configured to display a plurality of symbols (on reels 3L, 3C, 3R; page 10, line 22; Figure 2) for a player (page 8, line 24, et. seq.) to arrange the symbols (on reels 3L, 3C, 3R; page 10, line 22; Figure 2), the operation input device 6 includes a lever (page 14, lines 1-2; Figures 1 and 2) or a button to be operated by the player (page 8, line 24, et. seq.) to play a game, the internal lottery device 71 (page 21, lines 2-3; Figure 6) is configured to carry out an internal lottery (page 21, lines 2-3; Figures 6-9) of the game with a random number (from random number generator 36 and sampling circuit 37; page 21, lines 19-20; Figure 6) and the illumination device 104 (page 36, line 25, et. seq.; Figure 16) is configured to illuminate a tray 16 (page 13, line 24; Figures 1 and 2) formed on the cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2) of the gaming machine 1 (page 8, line 21, et. seq.; Figures 1 and 2).

The transparent member placement part 103 (page 37, line 4, et. seq.; Figures 14-16) is attached to the portion of the front side (see Figure 16) of the cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2) and the transparent member 105 (page 37, lines 10-16, et. seq.; Figures 13a-16) is detachably disposed between the illumination device 104 (page 36, line 25, et. seq.; Figure 16) and the tray (page 21, lines 2-3; Figures 6-9). When the belly panel 100 (frame member 110 and semi-transparent member 120; page 34, line 5, et. seq.; Figures 1 and 2) is in the exposed state (Figures 14-15), the transparent member placement part 103 (page 37, line 4, et. seq.;

Figures 14-16) is operative to slidably receive (page 37, lines 13-23; Figure 15) the transparent member 105 (page 37, lines 10-16, et. seq.; Figures 13a-16) and, when the belly panel 100 (frame member 110 and semi-transparent member 120; page 34, line 5, et. seq.; Figures 1 and 2) is in the cover state (Figure 16), the transparent member 105 (page 37, lines 10-16, et. seq.; 13a-16) is slidably received by the transparent member placement part 103 (page 37, line 4, et. seq.; Figures 14-16) such that the transparent member 105 (page 37, lines 10-16, et. seq.; Figures 13a-16) is positioned between the belly panel 100 (frame member 110 and semi-transparent member 120; page 34, line 5, et. seq.; Figures 1 and 2) and the portion of the front side (see Figure 16) of the cabinet 2 (page 9, line 5, et. seq.; Figures 1 and 2) thereby retaining the transparent member 105 (page 37, lines 10-16, et. seq.; Figures 13a-16) substantially immovable therebetween (page 38, lines 17-19; Figure 16).

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 1 and 3-6 are rejected under 35 USC 102 (b) as being anticipated by Sakamoto (JP 10174738).

Claims 1 and 3-6 are rejected under 35 USC 103 (a) as being unpatentable over Sakamoto.

Claim 2 is rejected under 35 USC 103 (a) as being unpatentable over Sakamoto in view of Corsetti (WO 98/05575).

VII. ARGUMENTS

Rejection of Claims 1 and 3-6 under 35 U.S.C. §102

Claims 1 and 3-6 are rejected under 35 USC 102 (b) as being anticipated by Sakamoto (JP 10174738). The rejection is respectfully traversed.

The courts have required for §102 anticipation that a single reference teach (i.e., identically describe) each and every element or step of the rejected claim or else the reference falls under §103. <u>Atlas Powder v. E. I. du Pont,</u> 750 F.2nd 1569, 224 USPQ 409 (Fed. Cir. 1984), <u>Jamesbury Corp. v. Litton Industrial Products</u>, 756 F.2nd 1556, 22 5 USPQ 253 (Fed. Cir. 1985).

Sakamoto teaches a gaming machine that makes it easier for a player to visually recognize tokens dispensed into a coin-receiving tray even if the gaming machine is installed in a dimly-lit place. An opening is formed at the lower face of a frame that is opposed to the coin-receiving tray. Light emitted from a florescent lamp illuminating a decorative panel eliminates the coin-receiving tray through a transparent resin plate covering the opening. Information such as "ABC" can be drawn on the transparent resin plate so that the information can be projected onto the coin-receiving tray.

Claim 1

Claim 1 is directed to a gaming machine including a cabinet, a belly panel, a symbol row display device, an operation input device, an internal lottery device, an illumination device, a transparent member placement part and a transparent member. Claim 1 recites that the cabinet has a front side and the belly panel is releasably connected to the cabinet and is operable to move to a cover state where a portion of the front side of the cabinet is covered by the belly panel and an exposed state where the portion of the front side of the cabinet is uncovered when the belly panel is positioned away from the cabinet. Claim 1 further recites that the symbol row display device is configured to display a plurality of symbols for a player to arrange the symbols, the operation input device includes a lever or a button to be operated by the player to play a game, the internal lottery device is configured to carry out an internal lottery of the game with a random number and the illumination device is configured to illuminate a tray formed on the cabinet of the gaming machine. Also, claim 1 recites that the transparent member placement part attached to the portion of the front side of the cabinet and the transparent member detachably disposed between the illumination

device and the tray. Additionally, claim 1 recites that, when the belly panel is in the exposed state, the transparent member placement part is operative to slidably receive the transparent member and, when the belly panel is in the cover state, the transparent member is slidably received by the transparent member placement part such that the transparent member is positioned between the belly panel and the portion of the front side of the cabinet thereby retaining the transparent member substantially immovable therebetween.

It is respectfully submitted that the rejection is improper because the applied art fails to teach each and every element of claim 1. Specifically, it is respectfully submitted that the applied art fails to teach:

- 1. that the cabinet has a front side and the belly panel is releasably connected to the cabinet and is operable to move to a cover state where a portion of the front side of the cabinet is covered by the belly panel and an exposed state where the portion of the front side of the cabinet is uncovered when the belly panel is positioned away from the cabinet;
- 2. that a transparent member placement part is attached to the portion of the front side of the cabinet; and
- 3. that, when the belly panel is in the exposed state, the transparent member placement part is operative to slidably receive the transparent member and, when the belly panel is in the cover state, the transparent member is slidably received by the transparent member placement part such that the transparent member is positioned between the belly panel and the portion of the front side of the cabinet thereby retaining the transparent member substantially immovable therebetween.

As a result, it is respectfully submitted that claim 1 is allowable over the applied art.

Claims 3-6

Claims 3-6 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Rejection of Claims 1 and 3-6 under 35 U.S.C. §103

Claims 1 and 3-6 are rejected under 35 USC 103 (a) as being unpatentable over Sakamoto. The rejection is respectfully traversed.

Claim 1

In rejecting claims under 35 U.S.C. §103, the United States Patent and Trademark Office bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A prima facie case of obviousness is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) quoting In re Rinehart, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1776). The mere fact that the prior art may be modified in the manner suggested by the Examiner neither makes the modification prima facie obvious or obvious unless the prior art suggested the desirability of the modification. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the references to arrive at the claimed invention. If the Examiner fails to establish a prima facie case of obviousness, the rejection is improper and will be overturned.

Examiners must make appropriate rejections regarding the obviousness of claimed inventions in light of the recent Supreme Court's decision in KSR International

Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). The familiar factual inquiries announced by the Supreme Court in its much earlier decision, <u>Graham v. John Deere Co.</u>, 383 U.S. 1, 148 USPQ 459 (1966), remain the basis for every decision regarding obviousness, i.e., Examiners will continue to consider:

- (1) the scope and content of the prior art,
- (2) the differences between the claimed invention and the prior art,
- (3) the level of ordinary skill in the pertinent art, and
- (4) objective evidence relevant to the issue of obviousness.

It is respectfully submitted that the applied art fails to teach or suggest the features of claim 1 as discussed above. Specifically, as mentioned above, it is respectfully submitted that the applied art fails to teach or suggest:

- 1. that the cabinet has a front side and the belly panel is releasably connected to the cabinet and is operable to move to a cover state where a portion of the front side of the cabinet is covered by the belly panel and an exposed state where the portion of the front side of the cabinet is uncovered when the belly panel is positioned away from the cabinet;
- 2. that a transparent member placement part is attached to the portion of the front side of the cabinet; and
- 3. that, when the belly panel is in the exposed state, the transparent member placement part is operative to slidably receive the transparent member and, when the belly panel is in the cover state, the transparent member is slidably received by the transparent member placement part such that the transparent member is positioned between the belly panel and the portion of the front side of the cabinet thereby retaining the transparent member substantially immovable therebetween.

Thus, since the applied art is devoid of the features listed as 1. - 3. above, it is respectfully submitted that one of ordinary skill in the art could not modify the features

of the applied art to arrive at the claimed invention. As a result, it is respectfully submitted that claim 1 is allowable over the applied art.

Guidelines promulgated by the United States Patent and Trademark Office (Federal Register, volume 72, number 195, October 10, 2007) note that Patent Examiners must continue to explain the reasoning that leads to a legal conclusion of obviousness when rejecting claims on that ground. The reasoning may still include the established Court of Appeals for the Federal Circuit standard that a claimed invention may be obvious if the examiner identifies a prior art teaching, suggestion, or motivation (TSM) to make it. However, in keeping with the KSR decision, the guidelines explain that there is no requirement that Patent Examiners use the TSM approach in order to make a proper obviousness rejection. Furthermore, the guidelines point out that even if the TSM approach cannot be applied to a claimed invention that the invention may still be found obvious.

To help Examiners make obviousness rejections that are supported by appropriate facts and reasoning, the guidelines identify a number of rationales suggested by the Supreme Court in the KSR decision. For each rationale, the Guidelines explain the underlying factual findings and provide guidance about how to reason from the facts to the legal conclusion of obviousness.

Based upon the guidelines, the Examiner must articulate the following:

- (1) a finding that the prior art included each element claimed although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element would have performed the same function as it did separately;

- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

It is respectfully submitted that, with regard to independent claim 1, the Examiner has failed to find that the prior art includes each claimed element as required under guideline paragraph (1) set forth above. As mentioned, the prior art simply fails to teach or suggest each of the claimed features of the invention.

Further, it is respectfully submitted that, since the Examiner has failed to find that the prior art includes each claimed element of the independent claim 1, guideline paragraphs (2), (3) and (4) cannot be satisfied.

Based upon the above, it is respectfully submitted that the Examiner cannot support the *Graham* factual inquiries as required under <u>KSR</u>.

Thus, in summary, it is respectfully submitted that one of ordinary skill in the art would not be motivated to modify the features of the applied art because such applied art is devoid of the recited features of claim 1. Because the applied art is devoid of all of the recited features of claim 1, it is respectfully submitted that the Examiner cannot establish a *prima facie* case of obviousness for the reasons set forth above either under the TSM (teaching suggestion motivation) test or the factual inquiries under Graham v. John Deere Co., supra. As a result, it is respectfully submitted that claim 1 is allowable over the applied art.

Claims 3-6

As mentioned above, claims 3-6 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Rejection of Claim 2 under 35 U.S.C. §103

Claim 2

Claim 2 is rejected under 35 USC 103 (a) as being unpatentable over Sakamoto in view of Corsetti (WO 98/05575). The rejection is respectfully traversed.

Corsetti teaches a removable insert for coin trays.

Claim 2 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that the dependent claim is allowable at least for the reasons claim 1 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

VIII. CLAIMS

A copy of the claims involved in this appeal is attached hereto in the Claims Appendix.

IX. EVIDENCE

No evidence is being presented and therefore there is no Evidence Appendix.

X. RELATED PROCEEDINGS

None.

Application No. 10/697,157

XI. CONCLUSION

It is respectfully submitted that the Examiner had failed to establish a *prima* facie case of anticipation for the reasons set forth above. Further, it is respectfully submitted that the Examiner had failed to establish a *prima facie* case of obviousness for the reasons set forth above either under the TSM (teaching suggestion motivation) test or the factual inquiries under <u>Graham v. John Deere Co.</u> supra. It is respectfully requested the Board overturn the rejection and allow the pending claims.

Respectfully submitted,

Dated: August 25, 2008

By: Carl Schaukowitch Reg. No. 29,211

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Enclosure(s):

Transmittal of Appeal Brief

Claims Appendix

Drawing Figures Appendix

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CLAIMS APPENDIX

Claims Involved in the Appeal of Application No. 10/697,157

1. (Previously Presented) A gaming machine comprising:

a cabinet having a front side;

a belly panel releasably connected to the cabinet and operable to move to a cover state where a portion of the front side of the cabinet is covered by the belly panel and an exposed state where the portion of the front side of the cabinet is uncovered when the belly panel is positioned away from the cabinet;

a symbol row display device configured to display a plurality of symbols for a player to arrange the symbols;

an operation input device comprising a lever or a button to be operated by the player to play a game;

an internal lottery device configured to carry out an internal lottery of the game with a random number;

an illumination device configured to illuminate a tray formed on the cabinet of the gaming machine;

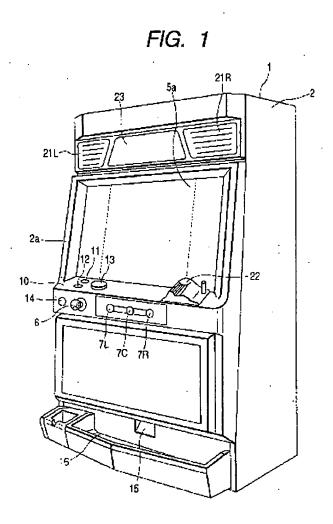
a transparent member placement part attached to the portion of the front side of the cabinet; and

a transparent member detachably disposed between the illumination device and the tray,

wherein, when the belly panel is in the exposed state, the transparent member placement part is operative to slidably receive the transparent member and, when the belly panel is in the cover state, the transparent member is slidably received by the transparent member placement part such that the transparent member is positioned between the belly panel and the portion of the front side of the cabinet thereby retaining the transparent member substantially immovable therebetween.

- 2. (Previously Presented) The gaming machine as claimed in claim 1, wherein the transparent member comprises: a bottom member configured to transmit light from the illumination device; a rear member fixed to the bottom member substantially at right angles therewith; and a side member fixed between the rear member and the bottom member.
- 3. (Original) The gaming machine as claimed in claim 1, wherein the transparent member is formed of a plastic member.
- 4. (Original) The gaming machine as claimed in claim 1, wherein the transparent member is sandwiched and fixed between the cabinet and a belly panel fitted into the cabinet.
- 5. (Original) The gaming machine as claimed in claim 1, wherein the transparent member is colored.
- 6. (Original) The gaming machine as claimed in claim 1, wherein the transparent member is decorated with a decoration including at least one of a character, a sign, and a design.

Drawing Figures Involved in the Appeal of Application No. 10/697,157



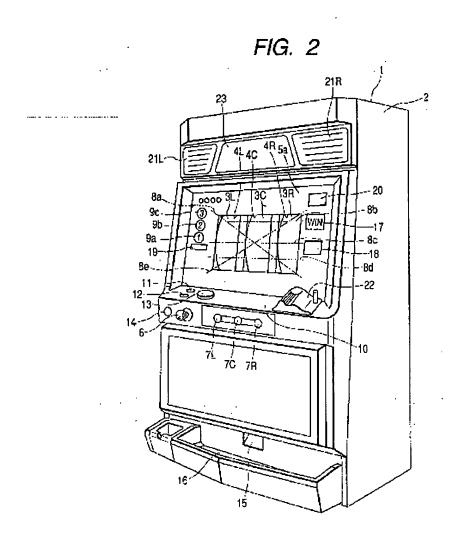
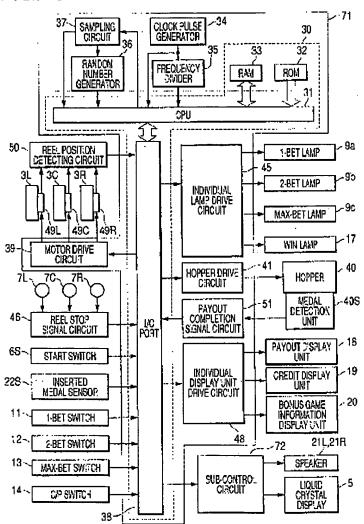


FIG. 6



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FIG. 7

WINNING STOP CONTROL TABLE (INTERNAL WINNING COMBINATION: SMALL PRIZE OF BELL)

(INTERIORE WINITING DOWNING OWNELL THEE OF DELL)						
LEFT REEL		CENTER REEL		RIGHT		
STOP OPERATION POSITION	STOP CONTROL POSITION	STOP OPERATION POSITION	STOP CONTROL POSITION	STOP OPERATION POSITION	STOP CONTROL POSITION	
00	19	OC	19	ÇO	18	
01	f9 ·	01	19	01	01	
02	ទេ	02	19	02	01	
03	03	03	63	03	01	
04	03	04	03	04	01	
05	03	05	03	- 05	C 5	
06	03	06	03	06	05	
07	03	07	07	07	05	
08	ΰ8	08	07	08	05	
C9	08	09	07	09	05	
10	08	10	- 07	10	10	
11	1:	11	11	11	10	
12	11	12	11	12	10	
13	11	13	11	13	10	
14	11	٠4	11	14	14	
15	15	15	15	15	14	
16	15	16	15	16	14	
17	15	17	15	17	14	
- 18	15	18	15	18	:8	
19	19	19	19	19	18	
20	19	20	19	20	18	

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FIG. 8

FORWARD PUSH, CENTER PUSH LOSING STOP CONTROL TABLE (INTERNAL WINNING COMBINATION: SMALL PRIZE OF BELL)

(INTERNAL MINIMA COMBINATION: BRINGE THEE OF PERS)					
LEFT REEL		CENTER REEL		RIGHT	
STOP OPERATION POSITION	STOP CONTROL POSITION	STOP OPERATION POSITION	STOP CONTROL POSITION	STOP OPERATION POSITION	STOP CONTROL POSITION
00	19	DO DO	19	00	19
01	19 ·	01	19	01	19
02	19	02	19	02	02
03	03	03	03	03	02
04	03	04	03	04	02
05	03	05	03 ·	05	02
06	03	06	03	06	60
07	03	07	07	07	06
08	08	08	07	08	06
09	68	09	07	09	06
10	08	10	07	10	06
11	11	11	11	11	11
12	11	12	11	12	:1
13	11	13	11	13 .	11
14	11	14	11	14	11
15	15	15	15	15	15
16	15	16	15	16	15
17	15	17	15	17	15
18	15	18	15	18	15
19	19	19	19	19	19
2C	19	20	19	20	19

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FIG. 9

REVERSE PUSH LOSING STOP CONTROL TABLE (INTERNAL WINNING COMBINATION: SMALL PRIZE OF BELL)

LEFT REEL CENTER REEL STOP OPERATION STOP CONTROL POSITION STOP OPERATION POSITION STOP CONTROL POSITION STOP CPERATION STOP CONTROL POSITION POSITION POSITION 20 · 0; C3 **C4** 5 6 **¢**4 G4 0B 1; :7 :7

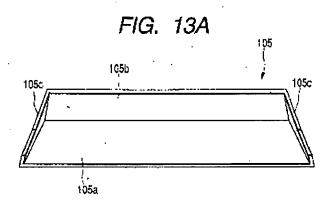
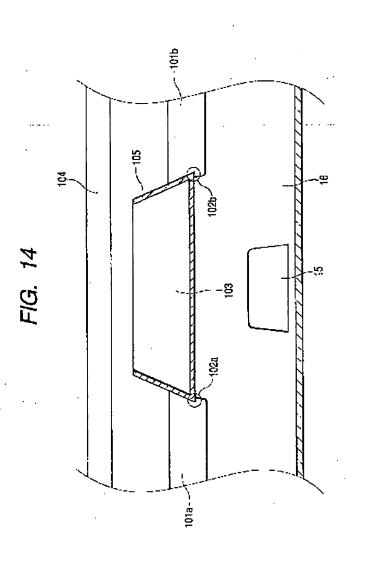


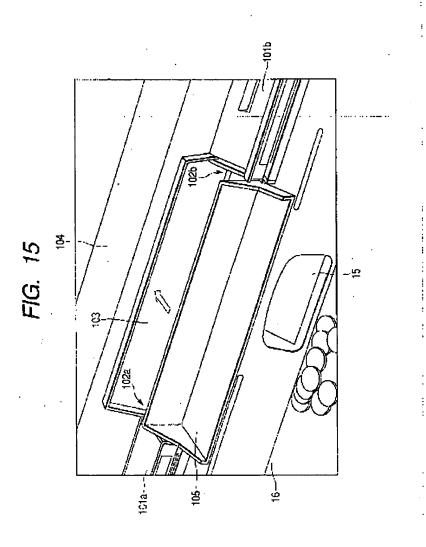
FIG. 13B

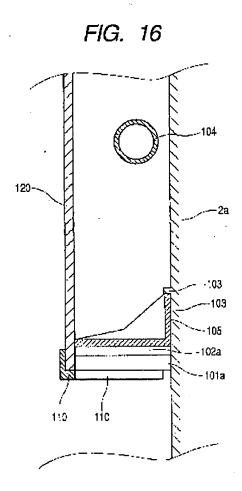
105

105c

105c







EVIDENCE APPENDIX

(No evidence is being presented)

Application No. 10/697,157

RELATED PROCEEDINGS

(None)